

IV. Remarks.

The Examiner entered the following rejections in the office action.

1. Claim 1-5 are rejected under 35 USC 103(a) as being unpatentable over Serkh (5,938,552) in view of Dinca et al. (6,165,091).

A rejection based on 35 U.S.C. §103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In Re Raynes, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed.Cir.1993). In the context of an analysis under §103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985); In Re Corkhill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed. Cir. 1985). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is . . . simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698 (Fed. Cir. 1983) (other citations omitted).

A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. American Hoist & Derek Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. (BNA) 763, 771 (Fed. Cir. 1984) (emphasis in original, other citations omitted).

There must be a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 999 (Fed.Cir.1999). This is because "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." Id. Accordingly, to establish a rejection under 35 U.S.C. §103, a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation

to combine the prior art teachings in the particular manner claimed. In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Serkh teaches a tensioner with a base, a pivot-arm that oscillates about a pivot secured to the base, a pulley attached to the pivot-arm, a compression spring with a first end operatively connected to the pivot-arm and a second end operatively connected to a shoe that presses a convex surface of the shoe against a concave arcuate surface of the pivot-arm, to the shoe held in place against a protuberance secured to the base by a balance of forces.

Dinca teaches a tensioner comprising a fixed structure that fixes to the engine. A movable structure is mounted for movement relative to the fixed structure in a belt tensioning and opposite directions. A pulley member has a belt engaging surface that engages with the belt. One of the fixed and movable structures has an interior surface defining a fluid chamber containing fluid and the other includes a chamber dividing structure. The chamber dividing structure defines first and second chamber portions on opposing sides thereof. A biasing element biases the movable structure in the tensioning direction to tension the belt. Relative movement of the movable structure in the tensioning direction displaces fluid from the first to the second chamber portion and increases fluid pressure in the first chamber portion and decreases fluid pressure in the second chamber portion, and the reverse occurs during movement of the movable structure in the opposite direction. The chamber dividing structure allows the fluid to flow between the chamber portions in a restricted manner so as to yieldingly resist the relative movement of the movable structure and thereby dampen such movement. The chamber dividing structure is constructed such that the fluid flow restriction is greater when the movable structure moves in the opposite direction than in the tensioning direction, thereby providing the movable structure with greater resistance to movement in the opposite direction than in the tensioning direction.

As to claim 1, there is no motivation to combine the references as suggested by the Examiner. Dinca teaches a tensioner using a torsion spring (184). Torsion spring (184) operates by being "wound" about its major axis. Winding torsion spring (184) causes the tensioner arm (30) to be put into tensioning engagement with a belt, col. 8, line 59 to col. 9 line 6. Dinca teaches that operation of member (144), notch (148) and pointer (150) are all dependent in part upon such rotary movement of torsion spring (184) caused by rotation of base (26) about bolt (22) which bolt is also used to secure base (26) to a mounting surface, col. 9, lines 9-21.

Serkh teaches use of a compression spring (36) captured between a shoe (52) and pivot arm (32). Pivot arm (32) pivots about pivot (34). Base (30) is secured in place by a bolt (66). Bolt (66) and pivot (34) are not coextensive.

Since Dinca is dependent upon the rotation of the base (26), this rotational feature is not compatible with the relatively lesser movement of base (30) required to adjust the instant invention. Namely, movement of base (30) adjusts spring (36) by compression of spring (36), page 7, lines 15-16. Movement of base (30) is inherently limited because excessive movement of base (30) with respect to spring (36) would misalign spring (36) with shoe (52). Misalignment would render the inventive tensioner inoperable. Indicator 91 and notch 90 are disposed with respect to base (30) and compression spring (36) and claimed in a manner consistent with use of the compression spring (36).

On the other hand, Dinca relies upon rotation of base (26) through any arc necessary to adjust the *torsion* spring (184) (emphasis added). The instant invention relies upon use of the *compression* spring, a feature not taught by Dinca, namely, Dinca's gross pivot arm adjustment feature. Hence, there is no incentive to combine the references.

Applicant requests the rejection be withdrawn.

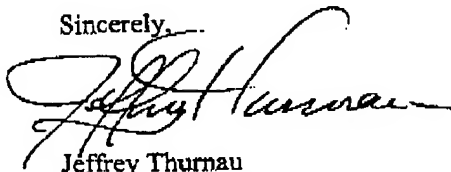
Claims 2-5 depend directly or ultimately from claim 1.

V. Fees.

Fees payable for this argument and request for extension of time may be deducted from deposit account 07-0475 in the name of The Gates Corporation.

Thank you for your attention to this case. If any questions arise, please call at the number below.

Sincerely,



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